

5 RESPONSE TO OFFICE ACTION

The undersigned is in receipt of an Office Action dated February 23, 2006. This paper responds to that Office Action dated February 23, 2006. The February 23, 2006 Office Action presents a surprise,
10 namely that the Examiner is now apparently for the first time citing Camp under 35 U.S.C. § 102(g)(2), having previously cited it only under 35 U.S.C. § 102(e).

It is perhaps instructive to review the status of the Examiner's rejection of all claims, and the status of the efforts by the undersigned to overcome that rejection.

15 ***How we got to where we are now.*** The present application was filed December 27, 2000, at a time when the inventor, Paul Giotto, was alive. More than five years has passed and Mr. Giotto is dead.

On June 1, 2005, the Examiner for the first time rejected all claims relying upon US Pat. No. 6,802,067
20 to Camp et al. ("Camp"), which is a patent that issued on October 5, 2004. The undersigned understood the Examiner to be citing Camp under 35 U.S.C. § 103 by way of 35 U.S.C. § 102(e), namely that the Examiner suspected that the filing date of Camp (October 27, 2000) might turn out to predate the date of invention by Mr. Giotto. The rejection was thus necessarily merely a "provisional" rejection since the Examiner did not yet know whether Mr. Giotto would be able to show a date of
25 invention prior to October 27, 2000. As such, Mr. Giotto had merely to show a date of invention prior to October 27, 2000 and the reference would be overcome. The colloquial way to say this is that the only burden upon Mr. Giotto was to "swear behind" Camp.

The undersigned reminds the Examiner that on November 26, 2003, this application was made
30 "special" because the state of health of Mr. Giotto was such that he might not be able to assist in the prosecution of the application if it were to run its normal course. The USPTO found that:

35 ... as a result of [Mr. Giotto's] chemotherapy treatment and clearly limited life expectancy, [Mr. Giotto] would probably be prevented from assisting in the prosecution of the instant application if it were to run its normal course.

Despite this finding by the USPTO, Camp was nowhere cited in the March 15, 2004 Office Action in this application, nor was Camp cited in the October 6, 2004 Office Action in this application. Had the Examiner cited Camp in either of these Office Actions, Mr. Giotta, still alive, might have been able to
5 assist, for example, in showing the date of invention, or in showing the various kinds of “diligence” which the Examiner now for the first time suggests need to be shown.

Had the Examiner cited Camp in timely fashion, for example in the March 15, 2004 Office Action, it is not now possible to know what the then-alive Mr. Giotta would have been able to do to show a date of
10 invention prior to the critical date of October 27, 2000. Instead, only after Mr. Giotta's death (in an Office Action dated June 1, 2005) did the Examiner for the first time cite Camp. This placed the undersigned in the difficult position of having to draw upon the limited abilities of Mr. Giotta's survivors to attempt to show a date of invention prior to the critical date of October 27, 2000.

15 In papers filed October 2, 2005, the undersigned provided some seventy-five pages of Declaration and Exhibits which were intended to assist the Examiner in understanding that the invention had been made prior to the critical date of October 27, 2000.

The Examiner's *sole criticism* of the seventy-five pages of October 2, 2005 documents was to say that
20 Exhibit B was illegible (December 15, 2005 Office Action, pages 9-10) and thus that the Examiner did not yet know “the valid date of the claimed invention” (id. at 10). The Examiner stated (id. at 9) that this was the only reason why the October 2, 2005 documents were “not persuasive”. It appeared from the December 15, 2005 Office Action that the only thing that remained, to secure an allowance of all pending claims, was to provide a legible copy of Exhibit B to the Examiner. It appeared that once a
25 legible copy of Exhibit B was provided, showing the date of invention to be prior to October 27, 2000, then Camp would be overcome and the claims would be allowed.

The undersigned received the December 15, 2005 Office Action on December 18, 2005. On that same day, the undersigned duly provided a legible copy of Exhibit B to the Examiner, together with an
30 explanation of how the previous Exhibit B had become illegible (poor quality scanning by USPTO personnel). The undersigned did this as a response “after final rejection”. MPEP § 706.07(f) provides that “replies after final should be processed and considered promptly by all Office personnel.” Despite

this, more than two months passed after the December 18, 2005 response of the undersigned, before the February 23, 2006 Office Action was mailed.

Now comes the February 23, 2006 Office Action in which, so far as the undersigned is able to discern, the Examiner admits that the undersigned has shown a date of invention by Mr. Giotta prior to October 27, 2000, thereby successfully “swearing behind” the reference under 35 U.S.C. § 102(e), but it appears the Examiner has apparently shifted ground and now apparently cites Camp under 35 U.S.C. § 102(g) instead of 35 U.S.C. § 102(e). It is a surprise to the undersigned to see (February 23, 2006 Office Action p. 4) that the Examiner now feels it necessary that Mr. Giotta show “diligence from a date prior to the date of reduction to practice of the Camp reference to either a constructive reduction to practice or an actual reduction to practice.” Nothing about 35 U.S.C. § 102(e) requires such a showing. 35 U.S.C. § 102(e) only requires that Mr. Giotta “swear behind” Camp. Stated differently, 35 U.S.C. § 102(e) only requires that Mr. Giotta show a date of invention prior to October 27, 2000, a showing which the Examiner apparently now admits has been made by Mr. Giotta.

This apparent shift by the Examiner, namely that Camp is now being cited under 35 U.S.C. § 102(g) when previously it was apparently cited under 35 U.S.C. § 102(e), is a big problem for the undersigned. It is a problem because Mr. Giotta is by now long dead and is unable to assist in showing these newly required proofs of “diligence”. And it is a problem because the undersigned is within two weeks of abandonment under the shortened statutory response period that the Examiner imposed in the final rejection in this case. Stated differently, most of the three-month response time available to the undersigned is gone now, and most of that response time passed waiting for the Examiner's prompt consideration.

The newly imposed requirement that the undersigned show “diligence” puts the undersigned in the position of being forced to ask which subsection, exactly, of 35 USC § 102 is being asserted by the Examiner.

Upon which section of 35 USC § 102 does the Examiner rely? In the Office Action dated February 23, 2006, the Examiner for the first time puts forth the view that the submission under 37 CFR § 1.131 need not merely show a date of invention prior to October 27, 2000, but must supposedly also show

“diligence” by the deceased Mr. Giotta “from a date prior to the date of reduction to practice of [Camp] to either a constructive reduction to practice or an actual reduction to practice.” The Examiner further for the first time puts forth the view that the submission under 37 CFR § 1.131 need not merely show a date of invention prior to October 27, 2000, but must supposedly also show “a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of [Camp].”

The Examiner's attention is respectfully drawn to MPEP § 2141.01 which says:

10 A 35 U.S.C. § 103 rejection is based on 35 U.S.C. § 102(a), § 102(b), § 102(e), etc. depending on the type of prior art reference used and its publication or issue date. For instance, an obviousness rejection over a U.S. patent which was issued more than 1 year before the filing date of the application is said to be a statutory bar just as if it anticipated the claims under 35 U.S.C. § 102(b). Analogously, an obviousness rejection based on a publication which would be applied under § 102(a) if it anticipated the claims can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR § 1.131.

From this it is understood that the Examiner cannot cite an arbitrary reference under 35 U.S.C. § 103 (e.g. a publication dated today), but is instead limited to citing a reference that somehow satisfies one of the time lines of one of the subsections of 35 U.S.C. § 102. To this end, the Examiner is requested to clarify which subsection of 35 USC § 102 supposedly provides a time line that permits the Examiner to assert Camp under 35 U.S.C. § 103.

The undersigned will briefly review the subsections of 35 USC § 102 in an effort to clarify this critically important matter.

30 35 U.S.C. § 102(a). ... the invention was [i] known or [ii] used by others in this country, or [iii] patented or [iv] described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

Does the Examiner contend that Camp somehow counts toward the invention being “known” by others in the US before the invention thereof by Mr. Giotta? If this is the Examiner's assertion, then it should be fully appreciated that the only burden upon the deceased Mr. Giotta is to show “invention” by Mr. Giotta prior to the date of the “knowledge”. If this is the case, the Examiner is requested to state the date of the purported knowledge so that this date may be duly compared with Mr. Giotta's date of invention.

Does the Examiner contend that Camp somehow counts toward the invention being “used” by others in the US before the invention thereof by Mr. Giotta? If this is the Examiner's assertion, then it should be fully appreciated that the only burden upon the deceased Mr. Giotta is to show “invention” by Mr.

5 Giotta prior to the date of the “knowledge”. If this is the case, the Examiner is requested to state the date of the purported knowledge so that this date may be duly compared with Mr. Giotta's date of invention.

Does the Examiner contend that Camp somehow counts toward the invention being “patented” before
10 the invention thereof by Mr. Giotta? I note that Camp was not patented until the relatively late date of October 5, 2004. The Examiner's attention is drawn to the fact that the present application was filed long before that date, on December 27, 2000.

Does the Examiner contend that Camp somehow counts toward the invention being “described in a
15 printed publication” before the invention thereof by Mr. Giotta? I note that Camp was not published until the relatively late date of October 5, 2004. The Examiner's attention is drawn to the fact that the present application was filed long before that date, on December 27, 2000.

20 35 U.S.C. § 102(b). ... the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States

Does the Examiner contend that Camp somehow counts toward the invention being “described in a printed publication” prior to December 27, 1999? I note that Camp was not published until the
25 relatively late date of October 5, 2004, and thus fails to have been published prior to December 27, 1999.

35 U.S.C. § 102(c). ... he has abandoned the invention

30 Does the Examiner contend that Camp somehow counts toward a showing that the invention has been abandoned?

35 35 U.S.C. § 102(d). ... the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application

for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States

Does the Examiner contend that Camp somehow counts toward the invention having been patented by Mr. Giotta in a foreign country prior to December 27, 2000 on an application filed prior to December 27, 1999?

35 U.S.C. § 102(e). ... the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

The undersigned had, prior to February 23, 2006, been under the impression that the Examiner was citing Camp pursuant to 35 U.S.C. § 102(e). Had this been the case, then the only burden on Mr. Giotta would have been to show that the "invention by the applicant" predated October 27, 2000. The Examiner's newly presented requirement that Mr. Giotta show "diligence" of various kinds, however, puts the undersigned in the position of no longer being confident that the Examiner was citing Camp pursuant to 35 U.S.C. § 102(e). It is hoped the Examiner will clarify this.

35 U.S.C. § 102(f). ... he did not himself invent the subject matter sought to be patented

Does the Examiner contend that Camp somehow supports the view that Mr. Giotta did not himself invent the subject matter sought to be patented?

35 U.S.C. § 102(g)(1). ... during the course of an interference conducted under [35 U.S.C. §] 135 or [35 U.S.C. §] 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Does the Examiner contend that there is or has been an interference conducted under 35 U.S.C. § 135 or 35 U.S.C. § 291?

35 U.S.C. § 102(g)(2). ... before such person's invention thereof, the invention was made in

5 this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Taking into account the Examiner's use of the term "diligence" at page 4 of the February 23, 2006 Office Action, and taking into account that the undersigned is unaware of any interference conducted under 35 U.S.C. § 135 or 35 U.S.C. § 291, it is the best guess of the undersigned that the subsection of
10 35 U.S.C. § 102 under which Examiner is now for the first time citing Camp is 35 U.S.C. § 102(g)(2).

It has already been established (and indeed by silence on this point in the February 23, 2006 Office Action, the Examiner appears to concede) that Mr. Giotta's date of invention is at least as early as September 19, 2000. Thus, for the Examiner's provisional rejection under 35 U.S.C. § 102(g)(2) to
15 prevail, it would be necessary for the Examiner to prove that Camp invented prior to September 19, 2000, and would further have to prove that Camp was diligent toward reduction to practice.

It is urgently requested that the Examiner clarify exactly which subsection of 35 U.S.C. § 102 is the subsection which the Examiner contends provides a time line that permits citation of Camp under 35
20 U.S.C. § 103.

Where did Mr. Giotta's invention take place? There is very little time left before the present application goes abandoned, given the shortened statutory period which the Examiner imposed on December 15, 2005. Thus, out of an abundance of caution, the undersigned has closely scrutinized the
25 February 23, 2006 Office Action in an attempt to discern whether the Examiner's continued rejections are based upon any grounds in addition to those discussed above. From page 4 of the February 23, 2006 Office Action, there appears to be some possibility that the Examiner suspects that the activities carried out as set forth in the seventy-five-page filing under 37 CFR § 1.131 somehow happened in a place that is (a) not the US, (b) not a NAFTA country, and (c) not a WTO country.

30 There are very few such places in the world any more, given that nearly every country of the world belongs to NAFTA or WTO. And the Examiner has pointed to nothing on the present record that suggests that any of the activities carried out took place in any non-WTO country. The undersigned

has diligently studied the present record and has been unable to find any hint or suggestion that any of the activities carried out took place in any non-WTO country.

5 Out of an abundance of caution, however, in the event that this is the Examiner's reason for maintaining the rejection, a Declaration is attached putting to rest any such suspicions. As may be seen from the Declaration, all of the activities set forth in the seventy-five-page filing under 37 CFR § 1.131 took place in either the United States or in Switzerland. The Examiner is respectfully requested to note that Switzerland is a WTO country.

10 Respectfully submitted,

/s/
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